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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,959	01/02/2001	Uwe Hansmann	DE9-1999-0077 (590.161)	9951
47049 7590 01/10/2008 FERENCE & ASSOCIATES LLC 409 BROAD STREET PITTSBURGH, PA 15143			EXAMINER AKINTOLA, OLABODE	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 01/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/752,959

Applicant(s)

HANSMANN ET AL.

Examiner

Olabode Akintola

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8,10-14,16,20 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8,10-14,16,20 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/2007 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, 8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kravitz (US 6029150) in view of Martino (US 6574314), in view of Vatanen (US 6169890), in view of Morrill, Jr. (US 5991749), in view of Herlin et al (US 6023689) and further in view Herbert et al (US 6023509).

Re claims 1 and 12: Kravitz discloses the invention substantially as claimed, including in a method of payment in a purchasing action (Col. 12, lines 49-51) performed by means of an electronic communication device (Col. 11, lines 57-60) between a customer using said electronic communication device (Col. 12, lines 45-49) and a provider offering goods or services (Col. 12, lines 51-54), steps of: building up a connection between said customer and said provider via a communication channel of said communication device (Col. 12, lines 45-51) and authorization of a customer to give a money transfer order (Col. 7, lines 19-45. See also Col. 29, line 19 to Col. 32, line 54 for details of authorization); upon receipt of a purchase order from said customer (Col. 12, lines 49-51), issuance of an electronic bill by said provider and transmission of said electronic bill to said customer Col. 12, lines 51-54); upon acknowledgement of said electronic bill by said customer transmission of a money transfer order from said customer to a payment provider (Col. 12, lines 56-59; Col. 12, lines 15-22); execution of said money transfer order by said payment provider by debiting an account of said customer (Col. 12, line 60 to Col. 13, line 12); sending a receipt of payment, which includes an encrypted digital signature of the payment provider, to said customer (Col. 8, lines 41-56); confirming the encrypted digital signature of said receipt (Col. 8, lines 35-40); and forwarding said receipt of payment to said provider offering goods or services (Col. 13, lines 13-26).

Kravitz does not specifically disclose the use voice channel between the customer and provider, authentication of customer identification using SIM of the electronic device prior to establishing a connection by the telecommunication provider and telecommunication provider authenticates

that the customer is authorized to give money transfer order using SIM; confirming the encrypted digital signature of said receipt by a confirmation center, wherein said confirmation center is other than said provider offering goods or services.

Martino discloses use of a voice channel (Col. 7, lines 19-43, Col. 3, lines 52-59). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kravitz to use a voice channel so as to perform simple verbal placement of orders and/or payment instructions and follow on information.

Vatanen teaches authentication of customer identification prior to establishing a connection (col. 3, lines 7-14 and line 56 through col. 4, line 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kravitz to include this feature. One would have been motivated to do so in order to identify the right of the customer to use the service.

Morrill discloses telecommunication provider authenticates that the customer is authorized to give money transfer order using ID (*SIM*) of the sending phone (col. 4, lines 1-64). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kravitz to include this feature. One would have been motivated to do so in order to ensure that the sender has prior service agreement with the provider for sending money.

Herlin discloses the use of a SIM for authentication at Col. 2, lines 10-40. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kravitz to perform authentication using the SIM of Herlin because this would facilitate secure payment.

Herbert teaches confirming the encrypted digital signature of said receipt by a confirmation center, wherein said confirmation center is other than said provider offering goods or services (Col. 7, lines 5-15). It would have been obvious to one of ordinary skill in the art at the time of

the invention to modify Kravitz to include this feature as taught by Herbert. One would have been motivated to do so for the obvious reason of ensuring that the receipt is valid before processing the order.

Furthermore, additional references are cited below that clearly show that these concepts are old and well known (See Tognazzini (col. 4, line 67-col. 5, line 12); Leonardi (Col. 3, lines 14-48) and Lee (abstract, col. 1, lines 28-30)).

Re claim 3: Kravitz discloses authentication by a communication provider via a service channel at Col. 12, line 55 to Col. 13 line 11 and Col. 29, lines 10-17.

Re claim 4: Kravitz discloses authentication before transmission of a money transfer order at Col. 25, line 30 to Col. 27, line 23.

Re claim 5: Kravitz discloses authentication after transmission of a money transfer order at Col. 29, line 18 to Col. 32, line 53.

Re claim 6: Martino discloses use of a service (data) channel for transmission of transaction data from a data transaction server at Col. 23, lines 35-59. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the service channel of Martino to transmit the transaction data of Kravitz because this would transmit transactions data without using valuable voice channel bandwidth.

Re claim 8: Kravitz discloses the use of an Internet connection at Col. 11, lines 50-60.

Re claims 10: Kravitz discloses the invention substantially as claimed. See the discussion of Claim 1. Kravitz does not disclose limitations relating to use of voice and service channels for transmission of the payment related documents. Martino discloses the use of two channels (Col. 7, lines 19-43) in a cellular system (Col. 3, lines 52-59) for transmission of payment related documents (Col. 23, lines 35-59). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kravitz to use the two channel cellular implementation of Martino because this would provide a familiar payment device having the capability of simultaneously presenting data (on screen 20, Fig. 5A) and allowing voice communication (via handset 54, Fig. 5A), thus relieving a user from having to switch between channels for different types of information. See *Martino* at Col. 7, lines 30-43, Col. 13, line 65-Col. 17, line 67.

Re claim 11: Kravitz does not specifically disclose authentication via a service channel. Martino discloses this limitation at Col. 20, line 56 to Col. 21, line 4 and Col. 7, lines 27-34. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kravitz to include the data channel authentication of Martino because this would provide transactions security without using valuable voice channel bandwidth

Re claims 13: Kravitz discloses computer program product databases at Col. 13, line 65 to col. 17, line 67. Official Notice is taken that computer readable media are stored on computer readable media. Examples include cache, memory, fixed disks, and removable media. It would have been obvious to one of ordinary skill in the art at the time of the invention to use such media to store the computer program product databases to store important data

Re claim 16: See the discussion of Claim 1. Kravitz further discloses that a payment provider maintains accounts for customers at Abstract, at least. Kravitz does not specifically disclose that the payment provider is a telecommunications company. Morrill discloses this limitation at col. 3, lines 24-28, col. 6, lines 46-62 and Fig. 1A. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kravitz to use the capabilities of a telecommunications company to maintain accounts disclosed by Morrill because such companies transfer account data and were technologically “savvy” enough to establish account maintenance systems and procedures.

Claims 14, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Kravitz in view of Martino in view of Vatanen in view of Morrill in view of Herlin in view Herbert, and further in view of US 6055566 Kikinis.

Re Claims 14, 20 and 23: Kravitz discloses the invention substantially as claimed. See the discussion of Claims 13, 1 and 12. Kravitz does not specifically disclose that the communication device is a personal computer using a SIM. Kikinis discloses this limitation at internet-capable cellular phone (PC using SIM) using wireless technology (col. 5, lines 48-52). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kravitz to use such a personal computer because this would provide the security of SIM authorization to a broader array of devices for payment processing.

Response to Arguments

Applicant's arguments filed 10/31/2007 have been fully considered but they are not persuasive.

In response to applicant's argument that Examiner has not established a prima facie case of obviousness under U.S.C. 103, Examiner respectfully disagrees. Examiner has provided suggestion or motivation to combine the references, there are reasonable expectations of success in making the combination and the prior arts teach all the claim limitations.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tognazzini (US 5739512) discloses payment receipt, which includes an encrypted digital signature of the issuer and confirming the encrypted digital signature of said receipt (col. 4, line 67-col. 5, line12).

Leonardi (US 6556680) discloses the use a SIM for authentication (col. 3, lines 19-47).

Lee (US 6658248) discloses the use of voice channel connection between customer and service provider (Figs, abstract and Summary).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

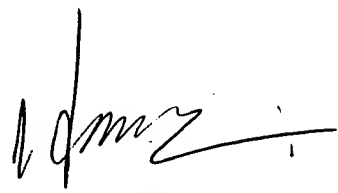
Application/Control Number:
09/752,959
Art Unit: 3691

Page 9

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA



HANI M. KAZIMI
PATENT EXAMINER